

REMARKS

Regarding Telephonic Interview

Applicants thank the Examiner for his clarification regarding his findings stated in the Office
5 Action. In the telephonic interview between the undersigned and the Examiner on February
12, 2004, prior art references cited against claim 1 were discussed; however, no agreement
was reached.

Regarding Claim Status

10 Claims 1-15 and 18-32 were pending. Claims 1-15 and 18-32 were rejected. Claims 1-4, 13-
14, 19-24, 28, 30, and 32 are amended herein. Support for the amendment can be found in the
specification as originally filed, particularly on pages 8, 16-18, and 20-22, and Figure 2. No
new matter is introduced. By this Amendment, claims 1-15 and 18-32 are pending.

15 *Regarding Claim Rejections*

Claims 1, 5-13, 18-24, 29 and 31 were rejected under 35 U.S.C. § 103(a) as being
unpatentable over Lawrence et al. (U.S. Pat. No. 6,289,342, hereinafter referred to as
“Lawrence”) in view of Wical (U.S. Pat. No. 6,487,545). The rejections are respectfully
traversed. Reconsideration is respectfully requested in view of the following remarks and the
20 amendments to the claims submitted herewith.

Applicants respectfully submit that the claimed invention recites subject matter not reached
by the closest prior art of record and therefore should be allowed. Applicants are in
agreement with the Office Action, which clearly stated on page 3,

25 “... as per claims 1, 29 and 31, Lawrence et al. and Wical do not explicitly teach that
said author information includes contact information of one or more senior managers.”

More specifically, the alleged Lawrence and Wical combination does not teach, *inter alia*,

“extracting from Internet web pages names and titles of senior managers” and
30 “evaluating a past tense relationship of the names and titles extracted.”

The Examiner nevertheless deemed the differences between the alleged combination and the claimed invention are “nonfunctional descriptive material” and are “not functionally involved in the steps recited.” Accordingly, the Examiner held that “this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability,” citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

It is respectfully submitted that the above paragraph is inconsistent with the USPTO’s definition of “descriptive material”.

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According to the USPTO’s analysis, “descriptive material is considered to be an abstract idea and therefore the claim would be rejected under 35 U.S.C. § 101 as not claiming patent eligible subject matter.” <http://www.uspto.gov/web/tws/wm4/wm4_3d_annex3.htm>

15 Clearly, the claims recite statutory patentable subject matter, hence the lack of 35 U.S.C. § 101 rejection. Since the claimed method is not an abstract idea, it is not descriptive material. Since it is not descriptive material, the above-referenced paragraph of the Office action does not apply, which means the claims are allowable under 35 U.S.C. § 103.

20 In the aforementioned telephonic interview, the Examiner further explained that he does not give “contact information of one or more senior managers” patentable weight because they are treated as “parameters” of action steps recited in a method claim.

The Examiner’s statements raised several concerns. First, such a claim interpretation seems
25 to be inconsistent with the US patent law where limitations recited in the claims should be given patentable weight. That is, all claimed elements and limitations, *including* “parameters”, must be considered in light of the entire application disclosure as a whole.

Second, according the USPTO Guideline, the “non-functional descriptive material” list does
30 not include “parameters”. On the contrary, whether a parameter is present or absent from the claims can be critical, *In re Rainer*, 305 F.2d 505, 507 n.3, 134 USPQ 343, 345 n.3 (CCPA

1962), *see also*, MPEP 2124. Suppose that “a red apple” is claimed. The word “red” is a parameter that must be considered when interpreting the claim because it narrows the scope to only “red” apples.

5 Therefore, Applicants respectfully note that the invention as claimed should be interpreted as a whole and that, as a whole, “names and titles of senior managers”, *inter alia*, are critically involved in the method steps recited. The *differences* between the claimed invention and the alleged combination are neither “non-functional descriptive material” within the USPTO definition, nor “parameters” per the Examiner’s interpretation and should be given patentable
10 weight.

When applying **35 U.S.C. 103**, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
 - (B) The references must be considered as a whole and must suggest the desirability and
15 thus the obviousness of making the combination;
 - (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
 - (D) Reasonable expectation of success is the standard with which obviousness is determined.
- 20 *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). *See also*, MPEP 2141.

The issue is therefore whether these *differences* would have been obvious to one of ordinary skill in the art at the time of the invention. Applicants respectfully submit that not only the
25 differences would not have been obvious to one skilled in the art at the time the invention was made, as established by *Lawrence*, they would not have possessed the general knowledge or skill to solve the problems.

First, Lawrence and Wical do NOT suggest the desirability to combine or modify with one
30 another. Thus, presumably, the rejection

“it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lawrence et al. to include that said combining of different forms of the same terms...”

would have been based on facts within the personal knowledge of the Examiner. When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner [MPEP 2144.03]. Applicants respectfully request that the Examiner cite a reference or provide an affidavit in support of his statement that someone having ordinary skill in the art at the time of the invention would have done so.

Notwithstanding the lack of proper motivation or desirability to modify, simply combining Lawrence and Wical still would NOT have arrived at an invention as set forth in the present claims, as the above-referenced page 3 of the Office action seems to agree.

In fact, Lawrence specifically teaches away from business information because only documents that are verified as valid research documents are processed [col. 8, lines 53-54]. Non-research documents such as business documents are deemed invalid and skipped [*id.*].

Again, as a whole, Lawrence teaches an autonomous citation indexing (ACI) system that creates a citation index from literature in electronic format [Abstract; col. 5, lines 50-51; col. 6, lines 27-30]. This ACI system does NOT compile business data. One skilled in the art would have recognized that there exist distinct differences between indexing citations of literature publication and compiling names and titles of senior management.

The ACI system and the present invention face different challenges and solve different problems. For example, the ACI system is capable of creating citation index from indexed papers but is not capable of identifying and extracting author identification, affiliations, and so on from arbitrary articles, e.g., semi-structured documents [col. 10, lines 23-49]. At best, the ACI system provides a link to the original Web page where an arbitrary article was located [*id.* at lines 49-51].

Lawrence does not teach or suggest searching arbitrary web pages containing senior management information. Lawrence does, however, establish the standard of general knowledge of one skilled in the art, i.e., “[f]or papers which are autonomously located on the web ... the problem is more difficult” [col. 10, lines 30-32]. “Accurately identifying the authors is somewhat harder [than extracting the title of the paper.]” [*id.* at lines 35-38]. Lawrence’s teaching indeed supports Applicants’ position that it was not in the general knowledge of one skilled in the art, at the time of the invention, to solve the problem of accurately identifying and extracting current names and titles of senior management from web pages autonomously located on the Internet.

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In addition, Lawrence does not teach or suggest evaluating a tense, for instance, a future or past tense, related to the author. This is because the ACI system does not evaluate whether an identified person is still an “author” and then select or discard accordingly. Since the ACI system ranks papers, journals, authors and so forth by the number of citations [col. 6, lines 30-31], there is no need to evaluate a tense or to discard papers, journals, authors and so forth associated therewith.

More importantly, contrary to a senior manager in a corporate world, a person once an “author” is an author for life. The past tense relationship evaluation of a senior manager’s name and title would have no value, no utility, and adds no functionality to the ACI system. In Lawrence, tense simply does not matter, negating any motivation or desirability to modify.

Wical does not fill this void. It is respectfully noted that the Examiner’s interpretation of Wical does not seem to commensurate with the method step at issue. The cited column 66 and lines 10-11 of Wical are directed to a routine called “IsWhatTense”, which returns the verb tense for the word being pointed to. Only “past” and “present” are valid. For example, if the word being pointed to is “was”, then IsWhatTense returns “past”. The IsWhatTense routine is one of 210 theme assessment routines specifically written to test each word/phrase in the exact context of the sentence [Wical, col. 57, lines 35-53]. The IsWhatTense routine is not deterministic to any words or any selection of the words. The lack of association to “author” or “senior management” notwithstanding.

On the contrary, in the present invention, the tense of “was” could be deterministic to the selection of senior management information being compiled. Below is a simplified scenario:

- A web page is obtained from the Internet and evaluated for parsing [Figure 2].
- 5 • A senior management title, “VP”, is extracted from the web page and a local content group is determined by boundary markers such as tags and keywords near “VP” [page 16, line 15, through page 17, line 3page 22, lines 1-15].
- The name, “John Doe”, is extracted from the local content group and associated with “VP”, among others such as “ABC Corporation” [page 17, lines 3-24].
- 10 • A past tense evaluation determines that John Doe “was” a VP. The extracted information is selected because a customer wants to get a history of senior management of ABC Corporation [page 21, lines 1-7].

Regarding Claim Interpretation

- 15 Applicants respectfully disagree with the Examiner’s interpretation that Lawrence’s teaching of “author” reads on the claimed term “senior managers”.

--Once an author, always an author.

Once a CEO, could be between jobs today. --

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- (1) Author of a Document is different from Senior Manager of a Company because author(s) of a document do not ever change, senior managers of company can and do change from time to time. An “Author<->Document” relationship once established is established for life. Once an Author has written a Document, he/she cannot “un-write” it. Finding senior managers of a
- 25 company is a much harder problem because one cannot rely upon a relationship similar to an “Author<->Document” relationship to establish a set membership. For example, suppose a citation is found that claims that Author A1 wrote Paper P1. If in other searches the CiteSeer finds Paper P1 itself, then the task of Author identification is made relatively easier because of the previously established relationship of “A1<->P1”. *No such relationship can be relied*
- 30 *upon for extracting Senior Managers of a Company.*

(2) Author(s) of a Document is different from Senior Managers of a Company because Senior Managers of a Company are part of a hierarchy at a company. Extracting a Senior Manager therefore is a not just extracting the name but also extracting the place where the Senior Manager occupies in the company hierarchy (title). Moreover, each Senior Manager could have multiple titles associated therewith over his life time. Associating the correct title to a name is an extremely important part that Lawrence simply does not have to deal with. Authors of a Document are not part of a hierarchy as it relates to a document.

(3) Reference to Author(s) of a Document is different from reference to Senior Managers of a Company because Author(s) of a Document is typically referenced only once at the top of the Document. In contrast, references to Senior Managers of a Company could occur multiple times at arbitrary places thus making the task of extracting them much harder. Lawrence does not deal with multiple "Author" references occurring at arbitrary locations in a Document.

(4) Lawrence does not teach Author *extraction* from a Document. Vague, general references made to "Learning techniques" do not teach the Author extraction process. In fact, as discussed above, Lawrence describes the Author extraction process as a "more difficult" and "harder" problem [col. 10, lines 23-49].

Conclusion


For the foregoing reasons, it is respectfully submitted that the present invention is unobvious in view of Lawrence and Wical, individually and in combination. It is further respectfully submitted that claims 1 and 30 recite subject matter not reached by the closest prior art of record under 35 USC § 103(a). Accordingly, claims 1 and 30 are submitted to be patentable. Reliance is placed on *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) and *Ex parte Kochan*, 131 USPQ 204 (Bd. App. 1960) for allowance of the dependent claims 2-15, 18-29, and 31-32, since they differ in scope from their parent independent claims which are submitted to be patentable.

This Response/Amendment is submitted to be complete and proper in that it places the present application in a condition for allowance without adding new matters. Favorable consideration and a Notice of Allowance of all pending claims are therefore earnestly solicited.

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The examiner is sincerely invited to telephone the undersigned at 650-331-8413 for discussing an examiner's Amendment or any suggested actions for accelerating prosecution and moving the present application to allowance.

Respectfully submitted,



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